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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,571	10/30/2003	Felicia Salomon	64373/3	5921
27871 7590 10/29/2007 BLAKE, CASSELS & GRAYDON LLP BOX 25, COMMERCE COURT WEST 199 BAY STREET, SUITE 2800 TORONTO, ON M5L 1A9 CANADA			EXAMINER HALE, ADAM G	
			ART UNIT 4175	PAPER NUMBER
			MAIL DATE 10/29/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/696,571

**Applicant(s)**

SALOMON ET AL.

**Examiner**

Adam G. Hale

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 7/11/2006.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Priority*

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Canada on 9/18/2003. It is noted, however, that applicant has not filed a certified copy of the Canadian application as required by 35 U.S.C. 119(b).

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 – 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Mukund US 2003/00699831.
4. **With respect to claim 1**, Mukund teaches a method for tracking compliance by a company to a set of regulatory requirements (see abstract), said method comprising:  
defining a set of company records relating to said company and storing said set of company records in a database (database contains information on a variety of matters concerning business, 0042, the system includes a collection component for

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data from users in database, 0047);

defining a set of questions related to requirements found in said set of regulatory requirements and storing said set of questions in said database (interpreted to be compliance assurance (CA) task information, 0053);

defining a set of default answers related to said set of questions and storing said set of default answers in said database (Add/Edit Tasks link allows the user to add and/or edit the CA information inputted for selected CA task[s], 0060);

assigning said set of questions for answering by a user at said company (Add/Edit Tasks link allows the user to add and/or edit the CA information inputted for selected CA task[s] and a contact person is assigned for a CA task, 0060, CA tasks are can be categorized by a responsible person, indicating that a person is assigned to each CA task, 0062);

receiving answers from said user to said set of questions and storing said answers in said database (Add/Edit Tasks link allows the user to add and/or edit the CA information inputted for selected CA task[s], 0060);

upon request, conducting an evaluation of compliance by said company to said set of regulations by accessing said database and extracting said answers said set of questions and said set of default answers therefrom; and evaluating said answers against said default answers and determining therefrom a compliance level of said answers to said set of regulatory requirements; and generating a report of regulatory compliance providing said compliance level (interpreted to be the monthly task compliance summary report, such that managerial oversight of the CA information is

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facilitated and compliances certain laws, rules, regulations ... is assured, 0063, Charts link displays a bar graph and shows CA tasks status as either open past due, closed, or open, 0062)

5. **With respect to claim 2**, Mukund teaches a method for tracking compliance by a company to a set of regulatory requirements wherein said compliance level is selected from one of the following levels:

incomplete compliance if said answers do not contain answers for all questions in said set of questions (interpreted to be the CA task status of open past due, 0063); full compliance if said answers are complete and said answers match requirements of said default answers (interpreted to be the CA task status of closed, 0063); and non-compliance if said answers are complete and said answers do not match requirements of said default answers (interpreted to be the CA task status of open, 0063).

6. **With respect to claim 3**, Mukund teaches a method for tracking compliance by a company to a set of regulatory requirements wherein assigning said set of questions for answering by said user at said company is performed by associating a title with said user and associating said title with said set of questions (interpreted to be the disclosure that persons are associated with particular CA tasks, 0037).

7. **With respect to claim 4**, Mukund teaches a method for tracking compliance by a company to a set of regulatory requirements wherein said method further comprises defining a set of control document records relating to said set of regulatory requirements, said set of control document records providing text extracted from said set of regulatory requirements and storing said set of control document

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records in said database; and said report further comprises a first link to said set of questions and a second link to said set of control document records (CA information relating to each site location is stored in a database, 0038, CA information includes legal information ... and corporate compliance information, 0036).

8. **With respect to claim 5**, Mukund teaches a method for tracking compliance by a company to a set of regulatory requirements wherein said method further comprises tracking any changes made to said compliance level; and upon request, producing an audit report identifying said any changes made to said compliance level (interpreted to be the update date 1362 and update user 1364 fields within the CA Audit Tracking System, see 0078 and Fig. 23).

9. **With respect to claim 6**, Mukund teaches a method for tracking compliance by a company to a set of regulatory requirements wherein said set of company records comprise a hierarchical arrangement of records (interpreted to be the CA information relevant to each site, 0038);

said set of questions comprise a hierarchical arrangement of records containing said set of default answers (interpreted to be disclosed by the teaching that the CA information concerning CA tasks stored in a database may be specific to a particular site, 0038); and

said set of control document records comprise a hierarchical arrangement of records and further contain a link to said set of questions and a link to said set of company records (interpreted to be disclosed by the teaching that CA information received may be cross-referenced to other CA information, 0038, and a summary report

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is provided to a managerial user that consists of a summary of CA tasks performed at a specific site, 0063, CA information is provided in response to an inquiry, 0008, in addition hypertext links are utilized in retrieving and accessing information in the database, 0006).

10. **With respect to claim 7**, Mukund teaches a method for tracking compliance by a company to a set of regulatory requirements as claimed in claim 6, said method further comprising upon request, producing a calendar of events for a timeframe associated with said set of regulatory requirements by accessing said database and extracting events from said database which are associated with said set of regulatory requirements for said timeframe; and generating a calendar report of said events from said database (interpreted to be the CA calendar showing CA tasks to be performed on certain specified days at the site location, 0060).

11. **With respect to claim 8**, Mukund teaches a system for tracking compliance of a company of a plurality of companies against a regulatory requirement (see abstract), said system comprising:

- a database containing records including a company record for said company; other company records for other companies in said plurality of companies (database contains information on a variety of matters concerning business, 0042);

- a set of question records related to said regulatory requirement, said set of question records including a set of questions and a set of default answers related to an aspect of said regulatory requirement (interpreted to be compliance assurance (CA) task information, 0053, Add/Edit Tasks link allows the user to add and/or edit the

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CA information inputted for selected CA task[s], 0060);

a user record for a user of said system associated with said company; and other user records for other users associated with said other companies (interpreted to be contact information stored for a contact person, 0075);

a module for entering administrative data relating to said company and storing said administrative data in said database in said company record; a module for entering user data relating to said user and storing said user data in said user record (interpreted to be disclosed by the ability of the system to allow for changes to the database so as to revise existing CA information, 0007);

a module for accessing said database and for determining a set of relevant questions for said user utilizing said user record and said company record (interpreted to be compliance assurance (CA) task information and the teaching that the CA task information may be modified, 0053);

a module for providing said set of questions to said user, for accepting answers to said set of questions and for storing said answers in said database (interpreted to be disclosed by the teaching of Add/Edit Tasks link, which permits the user to add and/or edit CA tasks in the database, 0060);

a module for evaluating compliance by said company to said aspect of said regulatory requirement by accessing said database, extracting said answers and said set of default answers, evaluating said answers against said set of default answers and determining therefrom a compliance level of said answers to said aspect of said regulatory requirement; and a module for generating a report of regulatory compliance



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providing said compliance level (interpreted to be the user interface for displaying a monthly task compliance summary report, 0063).

12. **With respect to claim 9**, Mukund teaches a system for tracking compliance of a company of a plurality of companies against a regulatory requirement wherein said module for evaluating compliance determines said compliance level from a selection from one of the following levels:

unassigned compliance if said user has not been entered into said system (interpreted to be disclosed that only authorized users, i.e. those that have been entered into the system, may access the database, 0046, and therefore if a user who had not been entered into the system would not be able to access the database and view a compliance, hence it would be unassigned);

incomplete compliance if said answers do not contain answers for all questions in said set of questions (interpreted to be the CA task status of open past due, 0063); full compliance if said answers are complete and said answers match requirements of said default answers (interpreted to be the CA task status of closed, 0063); and non-compliance if said answers are complete and said answers do not match requirements of said default answers (interpreted to be the CA task status of open, 0063).

13. **With respect to claim 10**, Mukund teaches a system for tracking compliance of a company of a plurality of companies against a regulatory requirement as claimed in claim 9, wherein said database further comprises a set of control document records relating to said regulatory requirement, said set

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of control document records providing text extracted from said regulatory requirement; and said module for generating a report further produces a first link to said set of questions and a second link to said set of control document records. (CA information relating to each site location is stored in a database, 0038, CA information includes legal information ... and corporate compliance information, 0036).

14. **With respect to claim 11**, Mukund teaches a system for tracking compliance of a company of a plurality of companies against a regulatory requirement wherein said system further comprises a module for tracking any changes made to said compliance level and producing an audit report identifying said any changes made to said compliance level (interpreted to be the update date 1362 and update user 1364 fields within the CA Audit Tracking System, see 0078 and Fig. 23).

15. **With respect to claim 12**, Mukund teaches a system for tracking compliance of a company of a plurality of companies against a regulatory requirement wherein said system further comprises a module to produce a calendar of events for a timeframe associated with said regulatory requirement by accessing said database and extracting events from said database which are associated with said regulatory requirement for said timeframe; and generating a calendar report of said events from said database (interpreted to be the CA calendar showing CA tasks to be performed on certain specified days at the site location, 0060).

16. **With respect to claim 13**, Mukund teaches a system for tracking compliance of a company of a plurality of companies against a regulatory requirement wherein a super

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user has access to said system and said system is responsive to requests from said super user to generate said report (the 'super user' is interpreted to be the manager user, the manager user having the authority to generate summary report for multiple sites, 0063, the multiple site disclosure of the reference is interpreted to be analogous to multiple companies of the application).

17. **With respect to claim 14**, Mukund teaches system for tracking compliance of a company of a plurality of companies against a regulatory requirement wherein said system generates a report for said super user indicating a list of questions assigned to said user (interpreted to be the disclosure that a summary report displays the monthly completed tasks for each assigned person, 0064).

18. **With respect to claim 15**, Mukund teaches a system for tracking compliance of a company of a plurality of companies against a regulatory requirement wherein said module for entering user data relating to said user further associates a title with said user; and said module for providing said set of questions to said user utilizes said title to identify said set of questions for said user (interpreted to be the disclosure that persons are associated with particular CA tasks, 0037).

19. **With respect to claim 16**, Mukund teaches system for tracking compliance of a company of a plurality of companies against a regulatory requirement as claimed in claim 15, wherein said system generates a second report for said super user indicating a list of questions assigned to said user (interpreted to be the disclosure that a summary report displays the monthly completed tasks for each assigned person, 0064).

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20. **With respect to claim 17**, Mukund teaches a system for tracking compliance of a company of a plurality of companies against a regulatory requirement as claimed in claim 16 wherein said user accesses said system through a web-enabled computer and said super user accesses said system through a second web-enabled computer (the system is accessible over a wide area network and client systems include web browsers, 0042).

21. **With respect to claim 18**, Mukund teaches a system for tracking compliance of a company of a plurality of companies against a regulatory requirement as claimed in claim 17 wherein said regulatory requirement relates to a requirement for a stock exchange (interpreted to be the disclosure that CA tasks and information include laws, rules, regulations, standards and policies relating to ... legal and corporate compliance, 0063)

In the event the reference is found to not teach that the regulatory requirements relate to a requirement for stock exchange, these differences are found to be nonfunctional descriptive data, not functionally related to the steps of the method or the structure of the system. The steps of the method would be performed the same no matter what the data. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579m 32 USPQ2d 1031 (Fed. Cir. 1994).

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**Conclusion**

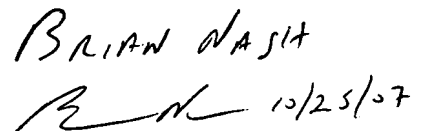
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 2003/0153991 discloses a compliance management system, as does 2002/0184068. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam G. Hale whose telephone number is 571-270-3509. The examiner can normally be reached on Monday through Thursday 7:30 - 6:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrence Till can be reached on 571-272-1280. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
AGH

10/24/07

  
10/25/07

Terrence R. Till  
Supervisory Patent Examiner